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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,131	04/11/2002	Philip Cohen	022.00160	5850

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EXAMINER

SWOPE, SHERIDAN

ART UNIT PAPER NUMBER

1652

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/868,131	Applicant(s) COHEN ET AL.	
	Examiner Sheridan L. Swope	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### DETAILED ACTION

Claims 1-49 are pending.

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 44 and 48, in part, 1, 3, 6-10, drawn to a method of activating a serum and glucocorticoid-induced protein kinase (SGK).

Group II, claim(s) 44 and 48, in part, 2, 4, and 5, drawn to a method of inhibiting a SGK.

Group III, claim(s) 34 and 35, in part, 11-17, 24, and 49, drawn to a SGK polypeptide.

Group IV, claim(s) 18-23, and 45, drawn to a polynucleotide encoding a SGK polypeptide.

Group V, claim(s) 44, in part, 25-30, drawn to a method for identifying modulators of a SGK.

Group VI, claim(s) 44, in part, 31 and 33, drawn to a method for identifying compound that binds to a SGK.

Group VII, claim(s) 44, in part, 32, drawn to a method for identifying a compound that modulates activation of a SGK.

Group VIII, claim(s) 34, 35, 37, and 38, in part, drawn to a compound that binds to a SGK.

Group IX, claim(s) 34, 35, 37, and 38, in part, drawn to a compound that modulates the activity of a SGK.

Group X, claim(s) 34, 35, 37, and 38, in part, drawn to a compound that modulates activation of a SGK by an interacting protein.

Group XI, claim(s) 36, drawn to a method for identifying a substrate of a SGK.

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Group XII, claim(s) 39, 40, 42, 43, 46, and 47, in part, drawn to a method of treatment using a compound that binds to a SGK.

Group XIII, claim(s) 39, 40, 42, 43, 46, and 47, in part, drawn to a method of treatment using a compound that modulates the activity of a SGK.

Group XIV, claim(s) 39, 40, 42, 43, 46, and 47, in part, drawn to a method of treatment using a compound that modulates activation of a SGK by an interacting protein.

Group XV, claim(s) 48, in part, and 41, drawn to a method of screening for a drug-like compound using a SGK.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons. The technical feature linking Groups I-XV appears to be that they all relate to SGKs. However, SGKs were known in the art (Webster, 1993). Therefore Groups I-XV share no special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Furthermore, the products of Groups III, IV, and VIII-X do not share a special common structural or functional feature while, the methods of Groups I, II, V-VII, and XI-XV do not use the same reagents or produce the same results. In addition, the methods of Groups I, II, V-VII, and XI-XV not do comprise all of the methods for making or using the products of Groups III, IV, and VIII-X. Accordingly, Groups I-XV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Searching more than one of the inventions of Groups I-XV would represent a burden on the Office for the following reasons. The search for the polynucleotide of Group IV would not encompass a search for the polypeptide of Group III, which would include searching the prior art for teachings of the purified protein. In addition, a search for Group IV, class 530, subclass 350,

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would not encompass a search for Invention III, class 435, subclass 193. Thus, a search of either Group III or IV would not encompass a search for the other group and searching both groups would be a burden on the Office. The specification does not disclose the identity of the compounds for the inventions of Groups VIII-X. A person of ordinary skill in the art would know that a compound that binds to a SGK does not necessarily modulate the activity of the SGK and, more likely that not, said compound would not modulate the activity of the SGK via an interacting protein. Furthermore, a compound that modulates the activity of the SGK directly would not be likely to also modulate the activity of the SGK via an interacting protein.

Therefore, a search for any one of Groups VIII-X would not encompass a search for any other invention of said groups. Furthermore, the search for the inventions of Groups VIII-X would not encompass the search for the polypeptide of Group III or the polynucleotide of Group IV, or vice versa. Thus, a search of more than one of Groups III, IV, and VIII-X would be a burden on the Office. A search for one of the methods of Groups I, II, V-VII, and XI-XV would not encompass a search for any other method of said groups because the methods do use the same steps and products and/or produce the same results. Thus, the search for more than one of the inventions of Groups I, II, V-VII, and XI-XV would be a burden on the Office. A search for the polypeptide of Group III, the polynucleotide of Group IV, or any compound of Groups VIII-X would not encompass a search for any of the methods of Groups I, II, V-VII, and XI-XV; furthermore, a search of said methods would not encompass a search for said polypeptide, polynucleotide, or compounds. Therefore, a search of one or more of Group III, IV, or VIII-X with any one or more of Groups I, II, V-VII, and XI-XV would be a burden on the Office.

Restriction between product and process claims has been required. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also M.P.E.P. 821.04, *In re Ochiai*, and *In re Brouwer*). Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right, if the amendment is presented prior to final rejection or allowance, whichever is earlier. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. To be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Sheridan L. Swope, Ph.D.

  
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